

### **REMARKS**

This responds to the Office Action mailed on June 1, 2006, and the references cited therewith.

Claims 14, 39, and 45 are amended, no claims are canceled, and no claims are added; as a result, claims 14-27, 39, and 45-47 are now pending in this application.

#### **Claim Objections**

Claims 39 and 45-47 were objected to because of informalities. The pending Office Action suggested the following changes:

In regards to claim 39, at line 6, insert ~~outer~~ after “beyond the.”

In regards to claim 45, at line 7, insert ~~that~~ between “such” and “the distal.”

Applicant has amended claims 39 and 45 as suggested. Reconsideration and withdrawal of the claims objections are respectfully requested.

#### **Affirmation of Election**

Restriction to one of the following species was required:

Species I directed to an outer tube with a slidable inner tube or cannula (figs. 1A-3A);

Species II directed to an outer tube with a slidable inner tube or cannula comprising a closure flap (figs. 4A-4D); and

Species III directed to an outer tube with a slidable inner tube further comprising a biasing element (figs. 3B-3D).

As provisionally elected by Applicant's representative, **Steve Lundberg**, on May 17, 2006, Applicant elects to prosecute the invention of Species II, claims 14-27, 39 and 45-47. Claims 1-13, 28-38 and 40-44 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The claims of the non-elected invention, claims 1-13, 28-38 and 40-44, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

§102 Rejection of the Claims

Claims 14, 17-18 and 25-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yoon (US Patent No. 5,797,888). Claims 14-15, 19-21 and 25-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Selmon et al. (US Patent No. 6,217,527). Claims 14 and 16-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bel et al. (US Patent No. 4,427,014). Applicant does not admit that Selmon is indeed prior art and reserves the right to swear behind this reference at a later date. Nevertheless the Applicant believes that the pending claims are distinguishable from the Selmon, Yoon, and Bel for at least the following reasons.

The rejection regarding Yoon stated that Yoon discloses a closure 24 having an exit hole 29. Yoon appears to show a seal 24 where “the seal members or flaps are normally biased to a closed position when no instrument is passed through the cannula” (col. 4, lines 44-46). The passage 29 of Yoon appears to only be present when the seal is forced open against the bias. Applicant is unable to find in Yoon a closure that is movable between an open and a closed condition, the closure having an exit hole in a closed condition of the closure, wherein the exit hole defines a travel path.

The rejection regarding Selmon stated that Selmon discloses a closure 110 having an exit hole 122. Selmon appears to show a deflecting housing 110 with a lateral opening 122. However, the lateral opening of Selmon is not located on a closure that is movable between an open and a closed condition.

The rejection regarding Bel stated that Bel discloses a closure 3 having an exit hole 4. Bel appears to show biopsy forceps with two jaws 3 that can be opened and closed. However, Bel does not appear to include any exit hole that is present in a closed condition of a closure.

In contrast, claim 1 as amended includes a closure that is movable between an open and a closed condition, the closure having an exit hole in a closed condition of the closure, wherein the exit hole defines a travel path.

Because each cited reference taken alone does not show every element of Applicant's independent claims, a 35 USC §102 rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect to independent claim 1 and to the remaining claims that depend therefrom at least as depending on an allowable base claim.

§103 Rejection of the Claims

Claims 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of Yoon ('888) and Bel et al. ('014) in view of Werne (US Patent No. 5,782,764). Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over anyone of Yoon ('888), Selmon et al. ('527) and Bel et al. ('014) in view of Sidall et al. (US Patent No. 4,741,326). Applicant respectfully submits that the additional reference of Werne fails to cure the rejection based on Yoon or Selmon for at least the reasons outlined above.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claims 21-24 and 27.

Claim 39 was rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of Selmon et al. ('527) in view of Yoon ('888). The rejection states that "Selmon et al. do not teach a closure that opens and closes. However Yoon discloses a probe deflection device comprising a closure 24 capable of closing and opening."

Applicant agrees that Selmon does not teach a closure that opens and closes. Further, as presented under 35 U.S.C. § 102 arguments above, Applicant submits that Yoon appears to show a seal 24 where "the seal members or flaps are normally biased to a closed position when no instrument is passed through the cannula" (col. 4, lines 44-46). The passage 29 of Yoon appears to only be present when the seal is forced open against the bias. Applicant is unable to find in Yoon a closure that is movable between an open and a closed condition, the closure having an exit hole in a closed condition of the closure, wherein the exit hole defines a travel path.

In contrast, claim 39 as amended includes inserting an inner tube having a tip into the outer tube having an outer surface and a closure having an exit hole such that the tip extends through the exit hole of the closure in a closed condition and beyond the outer surface of the outer tube.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the

references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claim 39.

Claims 45-47 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Selmon et al. ('527). As stated above, Applicant does not admit that Selmon is indeed prior art and reserves the right to swear behind this reference at a later date. Nevertheless the Applicant believes that the pending claims are distinguishable over Selmon for at least the following reasons.

The rejection states that Selmon discloses "inserting a stylet GW having an imaging marker and a blunt tip into an inner tube 114 to obturate the off axis exit hole 122." Claim 45 has been amended to recite inserting a stylet having an imaging marker and a blunt tip into an inner tube to obturate the off axis exit hole such that when the stylet is fully inserted into the inner tube, the blunt tip and the inner tube distal end form a smooth blunt tip suitable for tunneling through tissue of a biological subject.

The office action referred to the guidewire GW of Selmon as being capable of forming such a blunt tip, but the applicant respectfully asserts that the guidewire appears to not be smooth and blunt. As shown, it would appear that the guidewire GW would potentially get caught on or tear tissue it was passing through. Accordingly, the applicant's claim 45 is believed to be allowable over Selmon. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claims 45-47.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

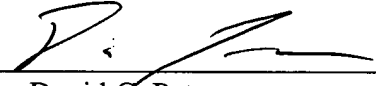
Respectfully submitted,

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Date 8-24-06

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22318-1450 on this 24<sup>th</sup> day of August 2006.

Name

Signature